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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,342

06/16/2005

Shahram Mihan

8019.101

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01/14/2008

NOVAK DRUCE DELUCA + QUIGG LLP

1300 EYE STREET NW

SUITE 1000 WEST TOWER

WASHINGTON, DC 20005

EXAMINER

LEE, RIP A

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

01/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,342	Applicant(s) MIHAN ET AL.	
	Examiner Rip A. Lee	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10-17-2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action follows a request for continued examination (RCE) under 37 § C.F.R. 1.114, filed on October 17, 2007. Claims 12 and 13 are pending.

Claim Rejections - 35 USC § 102

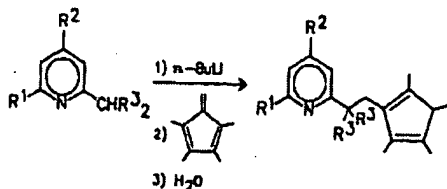
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Jutzi *et al.* (*J. Organomet. Chem.*, 1995).

Scheme 2 on page 182 of Jutzi *et al.*, reproduced below, shows a reaction that satisfies the reaction sequence set forth in the instant claims. Lithiation in the first step results in the formation of $R^1R^2C_4H_2N-C(R^3)_2Li$, which corresponds to “A anion” recited in the instant claims, where A is a substituted heteroaromatic ring system. Note in the claims that the structure of A is not specified, and there is nothing in the claims that indicates that the anion must reside at a specific location on A. The fulvene shown in the reaction scheme corresponds to fulvene (VIIIa) of the claims in which R^{4B} are hydrogen and R^{1A} - R^{4A} are methyl.



Based on this analysis, it is concluded that the subject matter of claim 12 is anticipated by the prior art of Jutzi *et al.*

Art Unit: 1796

Allowable Subject Matter

3. The following is a statement of reasons for the indication of allowable subject matter: Claim 13 is drawn to a process for preparing cyclopentadiene systems of formula (VIIa) by reaction of an $A-CR^{2B}R^{2B}$ anion with a cyclopentenone of formula (IX). Mihan *et al.* (WO 01/12641) and Enders *et al.* (*Chem. Ber.*, 1996) disclose preparative methods for preparing ligands 1-(2-(*N,N*-dimethylaminophenyl)-2,3,4,5-tetramethylcyclopentadiene and 1-(8-quinoliny)-2,3,4,5-tetramethylcyclopentadiene by reaction of tetramethylcyclopentenone with the corresponding heterocyclic anion precursors. In this case, heterocyclic anions do not possess the structure $A-CR^{2B}R^{2B}$, as recited in the instant claims. One of ordinary skill in the art would not have found it obvious to modify the synthetic procedure of the prior art (thereby failing to make the compounds of the prior art) to arrive at the subject matter of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu S. Jagannathan, can be reached at (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


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January 4, 2008